UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/750,138	12/29/2000	Dale W. Malik	00170; 190252-1720	6782

38823 7590 09/03/2010

AT&T Legal Department - TKHR
Attn: Patent Docketing
One AT&T Way
Room 2A-207
Bedminster, NJ 07921

EXAMINER	
NEURAUTER, GEORGE C	

ART UNIT	PAPER NUMBER
2443	

MAIL DATE	DELIVERY MODE
09/03/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DALE W. MALIK

Appeal 2009-000464
Application 09/750,138
Technology Center 2400

Before JOHN A. JEFFERY, ST. JOHN COURTENAY III, and STEPHEN C. SIU, *Administrative Patent Judges*.

SIU, *Administrative Patent Judge*.

DECISION ON APPEAL[1]

STATEMENT OF THE CASE

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-3, 6-8, 15, 21-23, 26-28, and 30-45.

---

[1] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

Claims 4, 5, 9-14, 16-20, 24, 25, and 29 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b).

The Invention

The disclosed invention relates generally to compacting electronic mail messages stored on a server computer (Spec. 4).

Independent claim 1 is illustrative:

> 1. A method for automatically managing an electronic mail server application on a host computer, comprising:
> checking an electronic mail message against a predetermined criteria;
> determining whether the message has been previously compressed;
> compacting a non-attachment portion of the electronic mail message if the predetermined criteria is satisfied and if the message has not been previously compressed; and
> storing the compacted electronic mail message.

The Examiner rejects claims 1-3, 6-8, 15, 21-23, 26-28, and 30-45 under 35 U.S.C. § 102(e) as being anticipated by Shaffer (US Patent No. 6,842,768; Jan. 11, 2005).

ISSUE

Appellant asserts that "Shaffer fails to determine whether the file was previously compressed" (App. Br. 6).

Did the Examiner err in finding that Shaffer discloses determining whether the message has been previously compressed?

FINDINGS OF FACT

The following Findings of Facts (FF) are shown by a preponderance of the evidence.

1. Shaffer discloses "when indicated by the connection or channel speed and the message or attachment size, a server makes a compressed version of the data file available for transmission" (col. 7, ll. 46-49).
2. Shaffer discloses a system to "determine when or how to compress messages based for example on different user's usage patterns and based on available system resources" (col. 8, ll. 14-16).

PRINCIPLE OF LAW

35 U.S.C. § 102

In rejecting claims under 35 U.S.C. § 102, "[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation." *Perricone v. Medicis Pharm. Corp.,* 432 F.3d 1368, 1375 (Fed. Cir. 2005) (citation omitted).

ANALYSIS

The Examiner points out that Shaffer discloses compressing (or "compacting") data based on a determination of the connection speed, channel speed, or message size (FF 1) and also compressing messages based on a user's usage patterns and available system resources (FF 2). However,

the Examiner has not demonstrated that Shaffer also discloses determining whether the message has been previously compressed.

The Examiner states that "Shaffer does in fact teach determining whether an electronic mail message has been previously compressed based upon its teachings that an uncompressed message is used to determine whether it should be compressed" (Ans. 14). However, while the Examiner states that Shaffer discloses using an uncompressed message to determine whether it should be compressed, the Examiner merely points to disclosures in Shaffer pertaining to compressing a message based on connection speed, channel speed, message size, usage patterns and available resources. None of these disclosures pertain to determining if a message has been previously compressed. In fact, the Examiner has not indicated that any determination is made at all in Shaffer of the compression status of the message prior to compression.

In addition, while the Examiner assumes that the message in Shaffer must be uncompressed prior to compression (but does not indicate where this assumption is disclosed in Shaffer), we note that Shaffer discloses "two different levels of compression" (col. 5, ll. 36-37). Given multiple levels of compression, the Examiner has not demonstrated that prior to compression of a message, the message cannot have been compressed to a different level of compression, for example.

Claims 21 and 35 recite similar features as claim 1. We therefore conclude that the Examiner erred in rejecting claims 1, 21, and 35, and claims 2, 3, 6-8, 15, 21-23, 26-28, and 30-45, which depend therefrom.

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that the Examiner erred in finding that Shaffer discloses determining whether the message has been previously compressed.

DECISION

We reverse the Examiner's decision rejecting claims 1-3, 6-8, 15, 21-23, 26-28, and 30-45 under 35 U.S.C. § 102(e).

REVERSED

msc

AT&T Legal Department - TKHR
Attn: Patent Docketing
One AT&T Way
Room 2A-207
Bedminster, NJ 07921